PATENT
P55971

#25 Walden 9/18/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of:

Appeal No. _____

KI-SEON KIM et al.

Serial No.: 09/503,240 Examiner: FISHER, MICHAEL

Filed: 14 February 2000 Art Unit: 3629

For: MONITOR CASE COMPRISING FACILE DETACH STRUCTURE

Attn: Board of Patent Appeals & Interferences

APPEAL BRIEF

Mail Stop: Appeal Brief - Patents
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to Applicant's Notice of Appeal filed on 8 July 2003, Applicant hereby appeals to the Board of Patent Appeals and Interferences from the final rejection of claims 1 through 25 in a final office action mailed on 8 April 2003 (Paper No. 21).

Folio: P55971
Date: 9/8/03
I.D.: REB/SS/sb

I. REAL PARTY IN INTEREST

Pursuant to 37 CFR § 1.192(c)(1)(as amended), the real party in interest is:

SamSung Electronics Co., Ltd.,
#416, Maetan-dong, Paldal-gu,
Suwon-city, Kyungki-do, Republic of KOREA

The inventor executed an Assignment dated 14 February 2000, which was recorded in the U.S. Patent & Trademark Office on 14 February 2000 at Reel 010614, frame 0028.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and interferences known to Appellant, Appellant's legal representatives, or assignee, which will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 through 25 are pending in this application. Claims 1 through 25 were all finally rejected in a final office action (Paper No. 21, claims 2-12, 14, 15, 17-20 and 22-25 objected to, claims 1, 13, 16 and 21 rejected). A Request for reconsideration was considered but did not place the application in condition for

allowance (Paper No. 22). Claims 1 through 25 are appealed herein.

IV. STATUS OF AMENDMENTS

An Amendment to claim 7 was requested in Applicant's Amendment filed on 16 October 2001 in response to a first Office action mailed on 17 July 2001 (Paper No. 5). No claim amendment was requested thereafter.

V. SUMMARY OF INVENTION

Referring to figure 3, a monitor 50 includes a front casing 51, a cathode ray tube 52 engaged to the back of the front casing 51, and a rear casing 53 integrally engaged with the front casing 51 for protecting the inner elements of the monitor from an external impact. (page 6, lines 11-13).

A plurality of snap portions (or indent portions) 60 are backwardly protruded from the upper portion of the back of the front casing 51. In addition, a plurality of engaging portions 70 (Figure 4) are formed at the front upper portion of the rear casing 53. Therefore, the engaging portions 70 are engaged to the snap portions 60, so that the front casing 51 and rear casing 53 are integrally engaged. (page 6, lines 14-17).

In addition, an engaging pin 80 is protruding from both rear lower portions of a rim portion of the front casing 51. A receiving hole 90 (figure 7) is formed at both front lower portions of the rear casing 53. Therefore, since the engaging pin 80 is engaged into the receiving hole 90, the lower portions of the front and rear casings, 51 and 53 respectively, are engaged. In addition, since the snap pin 100 is inserted into the receiving hole 90, the front casing 51 is not easily disassembled from the rear casing 53. (page 6, line 18 through page 7, line 1).

The monitor according to the present invention provides a casing capable of simplifying an assembling process, and decreasing the assembling time by having an easier assembling and disassembling operation of the front and rear casing. (page 14, lines 1-2 and page 2, line 22 to page 3, line 2).

VI. ISSUES

A. An ultimate issue is whether claims 1, 13, 16, and 21 were properly rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,233,026 by *Kim and Lee.* This issue subsumes the following subsidiary issues in the context of this case:

1. Whether, concerning Claims 1, 13, 16, and 21, the connection of the front case to the rear case of the present invention is not an obvious variation of the connection of a bottom shield with the front case of the patent of *Kim et al. '026.*

2. Whether, concerning Claims 1, 13, 16, and 21, the examiner failed to show a motivation to modify the patent into a monitor without a shield.

3. Whether, concerning claims 1, 16, and 21, under a 35USC§103 analysis for a double patenting rejection, *Kim et al. '026* does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al. '026.*

4. Whether the method claim 21 was improperly rejected under an obviousness type double patenting rejection because the claims are not obvious and patentable under 35U.S.C.§103(a) over *Kim et al. '026.*

5. Whether Claims 1, 13, 16 and 21 do not violate public policy.

B. Another ultimate issue is whether Claims 1, 13, 16, and 21 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over Beak (U.S. Patent 5,863,106). This issue subsumes the following subsidiary issues in the context of this case:

1. Whether *Beak '106* teaches or suggests all the claim elements (limitations) of the claimed invention of claims 1, 16, and 21.

2. Whether *Beak '106* teaches or suggests all the claim elements of the claimed invention of claim 13.

3. Whether the method claim 21 was improperly rejected under 35 U.S.C.§103(a) over *Beak '106*.

4. Whether the obviousness rejection of claims 1, 13, 16, and 21 can be sustained when the record contains no findings on the ordinary level of skill in

the art and lacks substantial evidence to support such findings if they had been made.

5. Whether the obviousness rejection of claims 1, 13, 16, and 21 is supported by findings and evidence of a specific teaching, suggestion, or motivation in the prior art to modify and adapt *Beak '106* to arrive at Appellant's specific device.

VII. GROUPING OF THE CLAIMS

Different references were cited against different claims and there are differences in the different claim rejections. Accordingly, the Appellant argues and therefore groups the claims as follows:

- Apparatus claims 1-12, and 16-20
- Apparatus claims 13-15
- Method claims 21-25

VIII. ARGUMENT

A. The Double Patenting Rejection

The examiner stated that claims 1, 13, 16, and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,233,026 by Kim and Lee (*Kim et al. '026*). The examiner admits that the conflicting claims are not identical but states that they are not patentably distinct from each other. As seen below, the obviousness type double patenting rejection is improper.

The Double Patenting Rejection is improper because it fails to satisfy the provisions set forth by the Manual of Patent Examining Procedure (MPEP) §804 for nonstatutory obviousness-type double patenting as seen below.

The inquiry in a nonstatutory-type double patenting rejection revolves around whether the claims in an application merely define an obvious variation of the other patent. *In re Emert*, 124 F.3d 1458, 44 USPQ 2d 1149, 152 (Fed. Cir. 1997) (citing *In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ 2d 2010, 2015 (Fed. Cir. 1993); *In re Vogel*, 422 F.2d at 441, 164 USPQ at 622).

If the application at issue is the later filed application or both are filed on the same day, a one-way determination of obviousness is needed in resolving the issue of double patenting. MPEP §804. Under a one-way test, if the scope of the application and the patent claims is not identical, the court must ask whether the former defines merely an obvious variation of the latter. *In re Goodman*, 11 F. 3d 1046, 29 USPQ 2d 2010, 2015-2016 (Fed. Cir. 1993).

The Examiner as suggested by §804 of the *MPEP*, must provide:

(a) The differences between the inventions defined by their conflicting claims, namely a comparison of the applied claims of the *Kim et al. '026* patent and each of the rejected claims in the above-captioned application; and

(b) The reasons why a person of ordinary skill in art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in the claim of the patent.

Furthermore, the Federal circuit has held that the Examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness. *See In re Longi*, 759 F.2d 887, 225 USPQ 645, 651 (Fed. Cir. 1985).

According to MPEP §804, since the analysis employed in an obviousness-

type double patenting determination parallels the guidelines for a 35USC§103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.,* 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35USC§103 are employed when making an obviousness-type double patenting analysis.

Therefore, the first step is for the Examiner to identify the invention claimed. The court of *In re Vogel* inquired the first step as "does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent." *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Therefore, the analysis is based on what the claim defines, and not on the claim language itself. The analysis should not focus on what the claim language discloses, but rather on what the claim language defines. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ 2d 1839, 1845 (Fed. Cir. 1992). Therefore, although the patent disclosure cannot be used as prior art, the disclosure can be used to determine the meaning of the claims in view of the disclosed embodiment. *In re Vogel*, 164 USPQ at 622. The specification is used to help interpret the claims of the patent but the specification cannot be read into the claims in an effort to support a double patenting rejection.

1. Concerning Claims 1, 13, 16, and 21, the connection of the front case to the rear case of the present invention is not an obvious variation of the connection of a bottom shield with the front case of the patent of *Kim et al. '026.*

Respectfully, the Examiner has failed in his burden of providing a *prima facie* case of obviousness under 35USC§103 as applied in an obviousness-type double patenting rejection as seen below.

Respectfully, the Examiner has failed in his burden of establishing a factual basis to support the legal conclusion of obviousness in rejecting claims 1, 13, 16 and 21 under an obviousness-type double patenting rejection. As mentioned above, according to MPEP §804, since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35USC§103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.,* 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35USC§103 are employed when making an obviousness-type double patenting analysis.

As mentioned above, the analysis should not focus on what the claim language discloses, but rather on what the claim language defines. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ 2d 1839, 1845 (Fed. Cir. 1992).

The factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) are summarized as follows with respect to present application:

(a) A determination of the scope and content of the patent claim(s) of *Kim et al. '026* relative to each of the **claims** rejected in this application; (emphasis added)

(b) A determination of the differences between the scope and content of the applied patent claim(s) of *Kim et al. '026* and the prior art as determined in (a) and the claim rejected in the above-captioned application;

(c) A determination of the level of the ordinary skill in prior art; and

(d) An evaluation of any objective indicia of non-obviousness.

In paper no. 21, the Examiner explains that "although the conflicting claims are not identical, they are not patentably distinct from each other because all

claims are directed toward a monitor case with snap fittings. The patent claims all the various snap fittings, snap portions, snap pins, shoulder portions, engaging pins, detents, holes and surfaces. The difference being that the patent further claims a lower shield that is absent from the instant application and does not claim the rear casing. However, the use of a rear casing would be obvious as the pins of the front casing would, of necessity, engage with something and this would be a rear casing."

The examiner mentions further on page 4 of paper no. 8 that the art shows the snapping of the shield to a case and since a monitor without a shield is well known in the art, it would have been obvious to make the same case without a shield and without the snap fittings with which it is secured.

First, under (a) A determination of the scope and content of the patent claim(s) of *Kim et al. '026* relative to each of the claims rejected in this application, all the claims of *Kim et al. '026*, in column 1, lines 15-17 of U.S. For example, in claim 1 of *Kim et al. '026*, it states in col. 6, lines 3-5, "...said through holes receiving the snap members to secure the bottom shield and the front case

together..." Patent 6,233,026, in its claims is defining that the bottom shield engages with a front case. *Kim et al. '026* is even entitled "Monitor Comprising Snap Engaging Bottom Shield." (emphasis added).

The presently claimed invention, however, specifically mentions the front case snap fitting with the rear case and not the front case snap fitting with the bottom shield. For example, claim 1 of the present invention has the snap portion of the front casing engaging with the rear casing and claim 13 states that "a rear casing engaging with said front casing."

The Examiner makes no determination of the scope of the claims.

Under (b) a determination of the differences between the scope and content of the applied patent claim(s) of *Kim et al. '026* and the prior art as determined in (a) and the claim rejected in the above-captioned application, there is a structural difference between the disclosure of the prior art patent to the extent that it is claimed in the presently claimed invention. *Kim et al. '026* 's claims (column 1, lines 15-17 of U.S. Patent 6,233,026) define the front casing connected with the bottom shield while the presently claimed invention, however, specifically claims the connection between the snap fitting of the front case with the rear case and not

the front case with the bottom shield.

The examiner, however, only states that "The difference being that the patent further claims a lower shield that is absent from the instant application and does not claim the rear casing." This statement, does not, however, properly determine the differences between the scope and content of the applied patent claims and the rejected claims.

The Examiner failed to satisfy (c) A determination of the level of the ordinary skill in prior art. In determining obviousness, the Examiner cannot consider whether he or she is personally of the opinion that the claimed invention is obvious. It is whether the claimed invention would have been obvious to one of ordinary skill in the art. On page 4 of paper no. 8, the Examiner only stated that it would have been obvious to make the same case without a shield and without the snap fittings with which it is secured without any determination of the level of ordinary skill.

The Examiner has also failed in providing objective evidence of nonobviousness.

As mentioned in MPEP§804, the obviousness type double patenting

parallels the guidelines for a 35USC§103 rejection. According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As required in the third element of the *prima facie* case, the prior art references do not teach or suggest the limitation of the front case connection with the rear case but instead shows specifically the bottom shield with the front case in the patent. In paper number 8, page 4, the Examiner states "As a computer without a shield is well known, it would be obvious to make the same case without a shield and without the snap fittings with which it is secured." The MPEP §706.02(j) demands that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." The examiner, instead, is using

his own knowledge instead of using the reference that are being relied upon. Only in limited circumstances may the Examiner use his own knowledge to show obviousness.

On page 2 of paper number 21, the Examiner argues that the use of a rear casing would be obvious as the pins of the front casing would, of necessity, engage with something and this would be a rear casing. Respectfully, the presently claimed invention involves the interconnection of certain members. To say that other pins or connection that may be assumed to connect to the rear casing does not then make an obviousness type double patenting rejection in light of *Kim et al. '026*. This reasoning would be improper because this involves a different set of interconnections. The fact is that as the Examiner admits, the rear casing is not claimed by *Kim et al. '026* and therefore, there cannot be an obviousness type double patenting rejection. The Examiner is arguing that the connection between the front case and the rear case is obvious in regards to the front case and a lower shield because the rear case would be involved anyway as a matter of necessity as stated in paper no. 21.

However, this logic does not address the specific connections that the

present invention is claiming. The fact is that the connections are different as seen specifically below. Furthermore, by suggesting of a different type of connection with the rear case, the patent would then be teaching away from the present invention.

If the Examiner instead wants to use the disclosure instead of the claimed subject matter of *Kim et al. '026* that defines the patent as reason for rejection, then the Examiner would be improperly rejecting the present invention under obviousness-type double patenting.

Furthermore, to just state that out of necessity, as stated by the Examiner on page 2 of paper number 21, the rear casing would engage with something and this would be a rear casing is improper to conclude under 35USC§103 obviousness analysis since the portions mentioned above are dealing with a shield with a printed circuit board. One cannot just arbitrarily remove an element from a reference. The reference as a whole must be looked at as defined by its claims. According to MPEP §2145, "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). This portion of *Kim et al. '026* cannot be

just ignored because according to MPEP §2141.02, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)."

2. Concerning Claims 1, 13, 16, and 21, the examiner failed to show a motivation to modify the patent into a monitor without a shield.

Respectfully, the examiner failed to show a proper motivation to modify the patent to use specific interconnections to connect to the front and rear casing rather than the front and lower shield as claimed in *Kim et al. '026*. The Examiner only states that through necessity the rear case must be engaged anyway since the pins of the front casing would of necessity engage something and this would be a rear casing. However, in fact, the claims defined in *Kim et al. '026* do not define the connection with the front and rear casing but the front casing with the shield member holding the printed circuit board.

Further, clearly then *Kim et al. '026* is actually teaching away from the

presently claimed invention if the Examiner is stating that a different set of connections are disclosed by *Kim et al. '026* for connections of the front and rear casing and as mentioned above. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999). The modification made by the Examiner concerning *Kim et al. '026* would be improper since as mentioned in *In re Dembiczak*, the showing must be "clear and particular" without broad generalized conclusory statements. *Id.* There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. There must be an explanation to what specific understanding or technical principle would have suggested the combination of references. *Id.* Being of necessity alone is not a proper motivation to modify nor is it correct in terms of the specific connections claimed as mentioned above.

3. Concerning claims 1, 13, 16, and 21, under a 35USC§103 analysis for a double patenting rejection, *Kim et al. '026* does not teach or

suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al. '026.*

As mentioned in claims 1, 16, and 21, the engaging pin (reference 80 of the present invention) at the lower rear surface of the front casing (reference 51 of the present invention) is not mentioned in the claims of *Kim et al. '026*. For example in claim 10 of *Kim et al. '026*, it is mentioned that "a front case having a rear side and a pair of guide rails extending rearward from the corners on said rear side thereof..." The pair of guide rails as seen in col. 4, lines 31-34 of *Kim et al. '026*, refers to reference 52 which accepts protruding ribs 56. On the other hand, in the present invention in claim 1 for example, the first hole of the lower portion of the front surface of the rear casing, is separately engaged to the engaging pin and the snap pin engages the first hole accommodating the prevention of the engaging pin from detaching from the first hole.

(Based on the above arguments, claims 13-15 stands and fall separately from the other claims.)

Furthermore, Applicant's independent apparatus claims 1, 13 and 16, and 21

illustrate an apparatus that is structurally, functionally and operationally different from the combination set forth in the claims of *Kim et al. '026*. Whereas Applicant defines a novel combination of a front casing, rear casing and an engaging snap pin, *Kim et al. '026* defines a different front case section, rear case section, first guide and second guide means, in conjunction with a snapping device pull for engagingly locking [a] printed circuit board. In fact *Kim et al. '026* is teaching away from the claimed invention by disclosing the snap engaging bottom shield instead of the snap engaging with the rear casing. All of the claims of *Kim et al. '026* (claims 1-23) explicitly teach a "bottom shield" that snap fits with the front case.

4. The method claim 21 was improperly rejected under an obviousness type double patenting rejection because the claims are not obvious and patentable under 35U.S.C.§103(a) over *Kim et al. '026*.

Concerning method claims 21, respectfully, the Applicant's process claim was improperly rejected by the apparatus claims of *Kim et al. '026*; these claims

are statutorily different in class and in subject matter. Respectfully, the Examiner has neglected to explain either the application of *Kim et al. '026* or his interpretation of those claims to support a comparison of each of the limitation set forth in the Applicant's method claims 21-25. For example in paper number 8, page 2, the Examiner stated concerning claims 21-25, "...the method of claims 21-25 could be used to produce the case as claimed in the patent."

Further, the method claims were not proven by the examiner to be inherent in the apparatus claims as mentioned in the MPEP §2112.02.

Further, not all the claim limitations of claim 21 are taught or suggested by *Kim et al.'026*. For example, *Kim et al.'026* does not teach or suggest the "forming a front casing ... forming a rear casing ... forming a snap pin." Further, there is no teaching or suggestion of the snap pin preventing the detaching of the front casing from the rear casing as mentioned in claim 1 of the present invention. Respectfully, the examiner has failed to provide a *prima facie* case of obviousness under 35USC§103.

(Based on the above arguments, claim 21-25 stands and fall separately from the other claims.)

5. Claims 1, 13, 16 and 21 do not violate public policy

As mentioned in the MPEP §804, "A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum* 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964)."

As shown above, the present application does not go against public policy because the present patent application does not extend the right to exclude. Claims 1, 13, 16, and 21 concern the interconnections of the front and rear casing while the claims of the *Kim et al.'026* patent define the interconnections of the front casing and the bottom shield (claims 1-22 of *Kim et al.'026*) as explained in detail above. Further, the claims of the present invention claim different specific

interconnecting members than the claims defined by *Kim et al.'026* as shown in detail above. The claims defined by *Kim et al.'026* are patentably distinct from the present application and therefore do not violate public policy.

B. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1, 13, 16, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beak (U.S. Patent 5,863,106, referred to hereafter as *Beak '106*).

According to MPEP 706.02(j), a *prima facie* case of obviousness under 35 U.S.C. §103 must be established by the examiner.

1. Concerning claims 1, 16, and 21, *Beak '106* does not teach or suggest all the claim elements of the present invention.

Concerning Claims 1, 16, and 21, the examiner mentioned that *Beak '106* discloses a monitor which includes an engaging pin (11 and 11') at the bottom of the front case which is received in a slot in the rear case (42, 42'). Respectfully, however, as pointed out in *Beak '106* in col. 3, lines 20-30, and lines 58-65, and figure 3, reference 11 and 11' holds a printed circuit board (PCB) 31 and not the rear case section. Member 42 and 42' do not receive reference 11 and 11', but they receive the printed circuit board 31. In col. 1, lines 1-10 of *Beak '106*, it mentions that the engaging pin relates to a structure affixing a printed circuit board within a monitor case. In col. 4, lines 36-40 of claim 1 of *Beak '106*, it states that the first guide affixes the printed circuit board. Therefore, *Beak '106* discloses a different structure than the present invention, and so does not teach or suggest the claimed present invention.

The Examiner on page 3 of paper number 21 states that *Beak '106* discloses the unnumbered features around the periphery of the rear case as seen in figure 1. However, if these are also engaging pins, then there is no mention of the snap pins. Even if the pins around the periphery and feature 11 are two different types of pins (one being the snap pin and the other the engaging pin), one pin does not prevent the other pin from detaching the front case from the rear case. It is not

clear from the drawing alone that the pins around the periphery of the case can prevent the case from disengaging. As shown above, feature 11 is involved in holding the printed circuit board in place. Therefore, *Beak '106* does not teach or suggests a snap pin that prevents the engaging pin from detaching as mentioned in claim 1 of the present invention. Both the snap pin and the engaging pins connect between the front case and rear case. *Beak '106* does not teach or suggest both structures interacting together in the manner presented in the claims of the present invention.

Furthermore, *Beak '106* does not teach or suggest the relationship of the engaging pin (80) at the lower rear surface of the front casing (51), the snap pin (100), and the first hole (90) on the lower portion of the front surface of the rear casing (53). As mentioned in claim 1, "...a front casing having ...at least one *engaging pin* at a lower rear surface of said front casing...a rear casing having... at least one *first hole* formed at a lower portion of the front surface, said rear casing integrally engaged with said front casing in such a manner that the *first hole* is separately engaged to the *engaging pin*...a *snap pin* engaging in the *first hole* accommodating the prevention of the *engaging pin* from detaching from the *first*

hole when the *engaging pin* of the front casing is integrally engaged into the *first hole* of said rear casing." (emphasis added). In *Beak '106*, the engaging pin of the font case does not separately engage with the first hole of the rear case since guide rails 11 and 11' (correlated to the engaging pins by the Examiner) do not even go into the guide ribs 42 and 42' (correlated to the first hole by the Examiner), but instead goes into the printed circuit board 31. Further, in the present invention, the snap pin provides a further connection to the same first hole that is connected already engaging with the first hole. Therefore, the same first hole accommodates the engagement of the engaging pin and the snap pin. *Beak '106*, however does not teach or suggest the snap pin engaging with the first hole. As seen in *Beak '106*, the first hole (guide ribs 42 and 42') is engaged with the printed circuit board 31 and not the snap pin (the examiner correlates the snap pin to the receiving section of the slot (below feature 12 of Fig. 4)) of *Beak '106* as seen in paper number 8, page 4 when the examiner states that it engages the engaging pin and hold it in place) . The receiving section is not engaged with the same first hole (ribs 42 and 42' of *Beak '106*) and the engaging pin (11 and 11' of *Beak '106*) as seen in Fig. 4 of *Beak '106*. Furthermore, nowhere in the reference of *Beak '106*, does it teach or suggest, that the receiving section will prevent the engaging pin

(feature 11 and 11' of *Beak '106*) from detaching. The receiving section has no contact with reference 11 as seen in Fig. 4 of *Beak '106*. No mechanism can be seen to teach or suggest that there is a "prevention from detaching" by the receiving section of the slot (42 and 42' of *Beak '106*) of the rear case in figure 4 of *Beak '106*. Therefore, *Beak '106*, as mandated by MPEP §706.02(j), does not teach or suggest a snap pin preventing the engaging pin of the front case from detaching from the first hole while it is also engaged with the first hole of the rear case.

The Examiner on page 3 of paper number 21, the Examiner admits that Beak does not disclose the snap portion at the top of the casing, but argues that shifting of parts is a matter of obvious design choice that is well settled in case law with the citation of *In re Japikse* 86USPQ70(CCPA 1950) which, according to the Examiner, states that shifting the location of parts would have been within the general skill of a worker in the art, and that it would have been well within the purview and obvious to shift the location of the portions as claimed.

Respectfully, however, *In re Japikse* is not stating that shifting of parts is a matter of design choice. The legal precedent cited by the Examiner is also

mentioned in the MPEP §2144.04 which mentions that *In re Japikse* mentions "Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device." In the presently claimed invention, the location of the snap portion would by just looking at the invention show that it would affect the operation of the apparatus.

The Examiner on page 3 of paper number 21, further argues that in *Beak '106*, the slot has a receiving section with a snap pin (below feature 12 as best seen in fig. 3) that engages the engaging pin to hold in place. Looking very closely at figure 3, the feature below feature 12 is not *engaging in the first hole accommodating the prevention of the engaging pin from detaching from the first hole when the engaging pin of the front casing is integrally engaged into the first hole of said rear casing* as mentioned in claim 1 of the present invention. First of all, the feature below feature 12 is not dealing with the first hole of the rear casing but with the printed circuit board 31. Further, the feature below feature 12 is not preventing the engaging pin from detaching from the first hole of the rear casing.

It is not even clear from the arguments what the Examiner is referring to as the engaging pins that are being prevented from detaching. The Examiner fails to mention what specifically the engaging pins correspond to in Beak that are being prevented from detaching. Further, *Beak '106* as seen by the feature below feature 12, does not teach or suggest both the engaging pin and the snap pin engaged with the first hole of the rear case.

2. Concerning claim 13, *Beak '106* does not teach or suggest all the claim elements of the present invention.

In paper no. 21, the Examiner, distinct from paper number 19, decided to reject claim 13 under 35USC§103. However as claimed in claim 13, *Beak '106* fails to teach or suggest *an indent portion protruding from said front casing and said rear casing in a certain direction; a detent portion forming at the opposite casing of said indent portion, said indent portion elastically transforming and inserting into said detent portion, and elastically transforming in the same direction as the engaging direction for thereby disassembling the front and rear casings; and a guide forming at said detent portion accommodating the direction of said indent portion to said detent portion in an engaging position.* The

combination of the above mentioned features are not taught or suggested by *Beak '106*. The Examiner mentions reference numbers 11, 11' and receiving slots 42 and 42'. However, as seen in figure 1 of *Beak '106*, these portions do not contact each other as in the detent and indent portions of claim 13, but *Beak '106* has a large printed circuit board 31 that acts with each element 42, 42' and 11, 11'. Clearly, since *Beak '106* does not teach or suggest all of the claimed elements does not make the claim obvious. One must look at the reference *Beak '106* as a whole. Further, no motivation was given for the modification of *Beak '106*.

(Based on the above arguments, claims 13-15 stands and fall separately from the other claims.)

3. The method claim 21 was improperly rejected under 35 U.S.C.§103(a) over *Beak '106*.

Concerning method claim 21, respectfully, the Applicant's process claim 21 were improperly rejected by the apparatus claims of *Beak '106*; these claims are

statutorily different in class and in subject matter. Respectfully, the Examiner has neglected to explain either the application of *Beak '106* or his interpretation of those claims to support a comparison of each of the limitation set forth in the Applicant's method claim 21. For example in paper number 21, page 3, the Examiner stated concerning claim 21, "The method of claim 21 would produce this configuration and is therefore inherently disclosed."

Further, the method claims were not proven by the examiner to be inherent in the apparatus claims as mentioned in the MPEP §2112.02.

Further, not all the claim limitations of claim 21 are not taught or suggested by *Beak '106*. For example, *Beak '106* does not teach or suggest the "forming a front casing ... forming a rear casing ... forming a snap pin." Respectfully, the examiner has failed to make a complete analysis in the rejection.

4. The Examiner Failed To Make Specific Findings On the Ordinary Level of Skill

The final rejection is based on the ordinary level of skill in the pertinent art.

Yet, the record contains no evidence, and no findings, as to that level of skill. The rejection does not even identify the pertinent art. (Is it the monitor art? Some other art?) Those defects undermine the rejection.

In Dembiczak, supra, the Federal Circuit overturned an obviousness rejection by the PTO because of its failure to make the kind of obviousness legal analysis commanded in *Graham v. John Deere Co.*, 376 U.S. 1, 17-18 (1966). Such an analysis must begin with making specific findings of fact regarding the level of ordinary skill in the art.[1] The *Dembiczak* Court said (175 F.3d at 1000-01, 50 USPQ2d at 1618):

> The Commissioner of Patents and Trademarks ("Commissioner") attempts to justify the Board's decision on grounds different from that relied upon by the Board, arguing that one of ordinary skill in the art would have been motivated to combine the references. Of course, in order to do so, the Commissioner must do what the Board did not do below: make specific findings of fact regarding the level of skill in the art ("a designer and manufacturer of trash and leaf bags,

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[1] See also *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ2d 1451, 1453 (Fed. Cir. 1997); *In re Huang*, 100 F.3d 135, 138, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996).

particularly one specializing in the ornamental and graphic design of such bags") ....

See also *In re Kaplan*, 789 F.2d 1574, 1580, 229 USPQ 678, 683 (Fed. Cir. 1986) ("Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was.").

Since any obviousness analysis present here rests on nonexistent findings and nonexistent evidence as to the level of ordinary skill in the art, the rejections are faulty and must be reversed.

5. The Rejection Is Defective for Lack of a *Graham-Gechter-Dembiczak* Analysis of Obviousness

The final rejection has substituted speculation and inference for the detailed factual and legal analysis which the Federal Court requires. The rejection is *not* based on a factual analysis of the record, stated in sufficient detail to elucidate the Examiner's reasoning by which he reached his ultimate factual and legal conclusions. There is not a proper analysis. That procedure and methodology cannot withstand scrutiny under *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir.

1997), and *In re Dembiczak*, 175 F.3d 997, 50 USPQ 1614 (Fed. Cir. 1999).

Gechter holds that the PTO, like other administrative agencies, has "a duty to provide reviewing courts with a sufficient explanation for [its] decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action." 116 F.3d at 1459.

The kind of obviousness analysis required here is summarized in *Dembiczak, supra*, 175 F.3d at 998:

> The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness.

These are the well-known *Graham v. Deere* factors. The four determinations listed above must rest on substantial evidence of record. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). There is no such supporting record here.

Conspicuously lacking in support of the instant final rejection are analyses of factors (2) and (4), substantial evidence in the record as to the conclusions (absent here) regarding those factors, and a reasoned explanation as commanded in

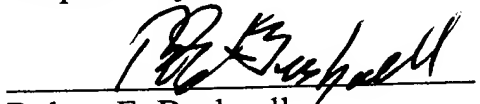
Gechter. The record before the Board shows only the Examiner's *assertion* that the present invention is obvious from *Beak '106*. No proper reasoned basis is provided for the assertion, nor any *Graham v. Deere* analysis of the facts. An applicant is entitled to a patent *unless* the Examining Staff establishes, *prima facie*, that he is not entitled to a patent because of obviousness. It is the Examining Staff's burden to establish obviousness over the prior art on the basis of a preponderance of evidence. *In re Dembiczak*, 175 F.3d 994, 1001, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999); *In re Epstein*, 32 F.3d 1559, 1564 (Fed. Cir. 1994); *In re Rijckeart*, 9 F.3d 1551, 1552, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Fine,* 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Yet, respectfully, the Examining Staff did not meet that burden here.

IX. CONCLUSION

In view of the law and facts stated herein as well as all the foregoing reasons, Appellant believes that the rejection is improper and respectfully requests that the Board refuse to sustain the outstanding rejection of claims 1, 13, 16, and

21 under the (non-statutory) judicially created doctrine of obviousness-type double patenting and of claims 1, 13, 16, and 21 under 35 U.S.C. §103.

Respectfully submitted,



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X. APPENDIX

CLAIMS UNDER APPEAL (1-25)

1. (Original) A monitor, comprising:

a front casing having at least one snap portion at an upper rear surface of said front casing and at least one engaging pin at a lower rear surface of said front casing;

a rear casing having at least one engaging portion at an upper front surface detachably engaging with the snap portion of said casing, and at least one first hole formed at a lower portion of the front surface, said rear casing integrally engaged with said front casing in such a manner that the first hole is separately engaged to the engaging pin, said front and rear casings enclosing a cathode ray tube; and

a snap pin engaging in the first hole accommodating the prevention of the engaging pin from detaching from the first hole when the engaging pin of the front casing is integrally engaged into the first hole of said rear casing.

2. (Original) The monitor of claim 1, wherein said snap portion includes an

elastic plate formed by cutting away a part of an inner structure of said snap portion, a first aperture rectangular in shape formed at an intermediate portion of the elastic plate and a slant surface formed at one end of said snap portion at a certain angle.

3. (Original) The monitor of claim 2, wherein said engaging portion includes a first detent fixed by the first aperture of said snap portion and a pair of guides formed in both directions of the first detent, the first detent stably engaging with the snap portion.

4. (Original) The monitor of claim 3, wherein the front portion of the first detent is circular, and the rear portion of the first detent includes a vertical wall.

5. (Original) The monitor of claim 3, wherein the distance between the guides is larger than the width of the snap portion, and both sides of the snap portion contact with the inner surfaces of the guides.

6. (Original) The monitor of claim 5, wherein the heights of the guides are

less than the height of the first detent, and the lengths of the guides are less than the length of the first detent.

7. (Once Amended) The monitor of claim 6, wherein when the front and rear casing are integrally engaged, a certain gap is formed between the front and rear casings, so that a certain tool including a driver is inserted into the gap when disassembling the front and rear casings.

8. (Original) The monitor of claim 1, wherein the engaging pin is a rectangular bar, and a pair of first shoulder portions reinforcing the engaging pin are formed at the upper end of the engaging pin, and a second detent is formed at an end portion of the lower surface of the engaging pin.

9. (Original) The monitor of claim 8, wherein a groove is formed at a top portion of an outer wall of the first hole, and a second aperture is formed at a portion backwardly distanced from the groove, and a pair of second shoulder portions each having a slant surface are formed at the bottom portion of the outer wall of the first hole, and the second detent of the engaging pin is engaged and

disconnected with the second shoulder portions.

10. (Original) The monitor of claim 9, wherein said snap pin further comprising:

a polygonal upper body;

a lower body formed at a lower portion of said upper body and having one end divided into first and second members; and

a connection portion accommodating integral connection of the upper and lower bodies.

11. (Original) The monitor of claim 10, wherein a third shoulder portion is downwardly protruding from one end of said upper body and is fixed at a second hole of the top portion of the outer wall of the first hole.

12. (Original) The monitor of claim 10, wherein the width of the lower body is less than the distance between the first shoulder portions and the lower body is received between the first shoulder portions when the first member is substantially parallel with the second member.

13. (Original) A monitor having a cathode ray tube, comprising:

a front casing;

a rear casing engaging with said front casing enclosing the cathode ray tube;

an indent portion protruding from said front casing and said rear casing in a certain direction;

a detent portion forming at the opposite casing of said indent portion, said indent portion elastically transforming and inserting into said detent portion, and elastically transforming in the same direction as the engaging direction for thereby disassembling the front and rear casings; and

a guide forming at said detent portion accommodating the direction of said indent portion to said detent portion in an engaging position.

14. (Original) The monitor of claim 13, wherein an engaging groove forming at said indent portion, a detent of said detent portion having a circular wall formed in the direction of the engaging groove and a vertical wall in the opposite direction, when engaging said indent portion with said detent portion, the indent portion is transformed by the circular wall, the detent is received into the

engaging groove of the indent portion, and when a certain separation force is applied, the vertical wall is engaged with the engaging groove for thereby supporting the front and rear casings.

15. (Original) The monitor of claim 14, wherein a gap is formed between said front casing and said rear casing allowing a certain tool to be inserted into the gap thereby pushing the indent portion, and transforming the detent so that the front and rear casings are separated from each other.

16. (Original) A monitor having a front casing and a rear casing for receiving a cathode ray tube, comprising:

an engaging pin extending from one of the front and rear casings in the direction of the opposite casing;

a wall surrounding a first hole engaging with said engaging pin when the engaging pin slides to the first hole; and

a snap pin engaging in said wall surrounding the first hole when said engaging pin is engaged in the first hole accommodating the prevention of said engaging pin from disengaging from said wall.

17. (Original) The monitor of claim 16, further comprising:

a groove forming at the top portion of said wall surrounding the first hole;

a first aperture forming at a portion backwardly distanced from the groove;

a pair of first shoulder portions each having a slant surface forming at a bottom portion of said wall surrounding the first hole; and

a first detent of the engaging pin connecting and disconnecting with the first shoulder portions.

18. (Original) The monitor of claim 16, wherein said engaging pin is a rectangular bar with a pair of second shoulder portions forming at the upper end of said engaging pin, and a second detent forming at an end portion of the lower surface of said engaging pin.

19. (Original) The monitor of claim 16, wherein said snap pin further comprising:

a polygonal upper body;

a lower body formed at a lower portion of said upper body and having one

end divided into first and second members; and

a connection portion accommodating integral connection of the upper and lower bodies.

20. (Original) The monitor of claim 16, further comprising:

an indent portion protruding from said front casing and said rear casing in a certain direction;

a detent portion formed at the opposite casing of said indent portion, said indent portion elastically transformed and inserted into said detent portion, and elastically transforming in the same direction as the engaging direction for thereby disassembling the front and rear casings; and

a guide formed at said detent portion accommodating the direction of said indent portion to said detent portion in an engaging position.

21. (Original) A method of constructing a monitor housing, comprising the steps of:

forming a front casing having at least one snap portion at an upper rear surface of said front casing and at least one engaging pin at a lower rear surface of

said front casing;

forming a rear casing having at least one engaging portion at an upper front surface detachably engaging with the snap portion of said front casing, and at least one first hole formed at a lower portion of the front surface, said rear casing integrally engaging with said front casing in such a manner that the first hole is separately engaged to the engaging pin, said front and rear casings enclosing a cathode ray tube; and

forming a snap pin engaging in the first hole accommodating the prevention of the engaging pin from detaching from the first hole when the engaging pin of the front casing is integrally engaged into the first hole of said rear casing.

22. (Original) The method of claim 21, wherein forming the snap portion comprising the steps of:

forming an elastic plate by cutting away a part of an inner structure of said snap portion;

perforating a first aperture in a rectangular shape at an intermediate portion of the elastic plate; and

forming a slant surface at one end of said snap portion at a certain angle.

23. (Original) The method of claim 22, wherein said engaging portion forms a first detent fixed by the first aperture of said snap portion and a pair of guides formed in both directions of the first detent, the first detent stably engaging with the snap portion.

24. (Original) The method of claim 23, wherein the distance between the guides is larger than the width of the snap portion, and both sides of the snap portion contact with the inner surfaces of the guides.

25. (Original) The method of claim 21, wherein forming said snap pin further comprising the steps of:

forming a polygonal upper body;

forming a lower body at a lower portion of said upper body;

dividing one end of said lower body into first and second members; and

forming a connection portion accommodating integral connection of the upper and lower bodies.

AF/3629

PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

KI-SEON KIM et al.

Serial No.:	09/503,240	Examiner:	FISHER, MICHAEL
Filed:	14 February 2000	Art Unit:	3629

For: MONITOR CASE COMPRISING FACILE DETACH STRUCTURE

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Sir:

Accompanying this transmittal is an Appeal Brief in support of a Notice of Appeal filed on 8 July 2003. A fee of **$320.00** for filing an Appeal Brief has been **previously** paid on **22 July 2002**, together with an Appeal Brief filed on 22 July 2002. Thus, we believe that there is **no fee** incurred by filing this Appeal Brief. Should any additional fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 in that amount. Please inform the Applicant of any transactions involving the Deposit Account.

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